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RL

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/011,634 04/03/98 ARONHIME M P16370

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IM22/0705

EXAMINER

GRENDZYNSKI, M

ART UNIT

PAPER NUMBER

1774

DATE MAILED:

(b)
07/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/011,634

Applicant(s)
Aronhlme et al.

Examiner
Grendzynski, Michael E.

Group Art Unit
1774



☒ Responsive to communication(s) filed on Oct 8, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-65 is/are pending in the applicat

Of the above, claim(s) 1-28 and 46-65 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 29-45 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5, 11, 12

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1774

DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Group II (claims 29-45) in Paper No. 15 is acknowledged. The traversal is on the ground(s) that reasons for why unity of invention is lacking were not stated. This is not found persuasive because such reasons were set forth in Paper No. 13. To reiterate, 37 C.F.R. 1.475 provides that there exists unity of invention only when there is a special technical relationship among those inventions involving one or more of the same corresponding special technical feature. "Special technical feature" is defined by 37 C.F.R. as those technical features which define a contribution over the prior art. Since Applicants' special technical feature is an image transfer member with an outer release layer of silicone, this feature must define a contribution over the prior art. Clemens discloses an image transfer member having an outer release layer comprising silicone; consequently, the special technical feature of the instant invention does not define a contribution over the prior art. As a result, lack of unity of invention exists.

Applicants further argue that since a search was formed on all claims during the international prosecution of the instant application, that the claims need not be searched during the application's national stage prosecution, and thus no lack of unity need be found. 37 CFR 1.499, however, provides that an examiner may require an election if lack of unity of invention is found to exist. As indicated above, lack of unity of invention does exist; consequently, the requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-28 and 46-65 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim. Applicant timely

Art Unit: 1774

traversed the election requirement in Paper No. 15. A complete reply to the final rejection must include cancellation of non-elected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 U.S.C. § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 29-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Presently, the exact structure of the image transfer member is unclear. What else exists within the member besides an "outer release layer?" Is there a support? Other layers? Additionally, there is an outside layer, but no articulated layers on the inside. Was this intended? For purposes of examination, it has been assumed that a support layer exists and that the release layer is the top layer.

With respect to claims 42-44, the use of the term "added" makes the claim ambiguous. This term suggests there are already these components in existence, and these additives are in addition to those components. Is this the case?

With respect to claim 45, the phrase "enhanced utilizing primer" renders the claim ambiguous. This phrase is neither defined in the spec, nor does it have a well-defined meaning in the art. The specification mentions a primer generally, but not an enhanced utilizing primer. Are these the same?

Claim Rejections - 35 U.S.C. § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1774

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 29-38 is rejected under 35 U.S.C. 102(b) as being anticipated by Shinozaki (DE 4426820).

Applicants claim an image transfer member comprising a support having a top layer comprising a condensation type silicone. Shinozaki discloses an image-forming member comprising a support, an image-forming layer, and a layer comprising a condensation-type silicone rubber layer having applicants' claimed thickness. *See* col. 3, lines 19-27; col. 7, lines 1-15 and 66-67. With specific regard to claims 35-38, there is no indication by Shinozaki that its silicone layer contains any silicone oil.

7. Claims 29 and 35-38 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Moeller (4,216,252). Moeller discloses a release coating which may be placed on any support comprising an organohydrogenpolysiloxane. *See* col. 2, lines 1-65. There is no indication that any silicone oil is present.

Claim Rejections - 35 U.S.C. § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 29-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendrickson (4,600,673). Applicants claim an image transfer member comprising a support having a top layer comprising a condensation type silicone. Hendrickson discloses a photoconductive assembly comprising an

Art Unit: 1774

electroconductive substrate, a photoconductive layer, and a topcoat of a condensation type silicone polymer. *See* col. 2, lines 45-48 and col. 3, lines 35-66.

With regard to claims 30-34, Hendrickson discloses a thickness within applicants' claimed range. *See* col. 5, lines 51-59.

With specific regard to claims 39-41, The experimental modification of this prior art in order to ascertain optimum operating conditions (the amount of filler materials) fails to render applicant's claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. The amount of filler materials in a coating layer is a common concern in the art, motivated by the desire to provide improved coating property, or a filler which performs a specific function to a desired degree (e.g., a biocide). Consequently, it would be obvious to optimize.

With specific regard to claim 42-43, Hendrickson discloses that its topcoat comprises a cross-linking agent and a catalyst. *See* col. 5, lines 19-40.

Conclusion

10. Should you have any questions concerning this communication, please direct them to Michael E. Grendzynski at telephone number (703) 305-0593. The examiner can be reached at this number from 7:00 a.m. to 3:30 p.m. Monday-Friday. If attempts to reach the examiner by telephone prove unsuccessful, the examiner's supervisor, William Krynski, can be reached at (703) 308-2376. Please allow the examiner twenty-four hours to return your call.

A facsimile center has been established for Group 1700 on the 8th floor of Crystal Plaza 3. The hours of operation are Monday through Friday, 8:45 am to 4:45 pm. The fax numbers for Art Unit 1774 are (703)

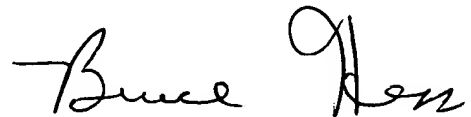
Application/Control Number: 09/011,634

Page 6

Art Unit: 1774

305-3599 for official after final faxes, and (703)305-5408 for all other official faxes. Use of the Group 1700 center will facilitate rapid delivery of materials to examiners in Art Unit 1774.

Any inquiry of a general nature, or those relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-2351.



BRUCE H. HESS
PRIMARY EXAMINER
GROUP 1300



Michael E. Grendzynski
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June 30, 2000